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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,207	01/08/2001	Michael Stuke	HUBR1165 100	5279

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EXAMINER	
ROSSI, JESSICA	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/647,207	**Applicant(s)** STUKE ET AL.	
	Examiner Jessica L. Rossi	**Art Unit** 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 23-24,26-34,36,45-46.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 2/16/05. Claims 23-24, 26-34, 36 and 45-46 are pending.

2. The rejection of claims 23-24, 26-34, 36 and 45 under 35 U.S.C. 112, 1st paragraph, as set forth in paragraph 6 of the previous office action, has been withdrawn in light of the amendment to claim 23.

3. It is noted that amended claim 23 is now identical to previous claim 46, which was fully addressed in paragraph 8 of the previous office action. Applicant is invited to reread that rejection.

4. It is noted that the limitations in amended claim 46 have already been addressed with respect to claim 45; therefore, Applicant is directed to paragraph 8, specifically p. 7, of the previous office action where the examiner rejected claim 45.

Response to Arguments

5. Applicant's arguments filed 2/16/05 have been fully considered but they are not persuasive.

6. On page 6 of the remarks, Applicant argues that Oshida teaches cooling down to 55°C whereas amended claim 23 states cooling down to about 40°C.

Applicant is invited to reread the rejection of claim 46 (which amended claim 23 is now identical to) as set forth above in paragraph 8 of the previous office action. The examiner would first like to point out that cooling down to a temperature of 55°C is only one of many examples provided in the Oshida reference.

To reiterate, Oshida teaches cooling down to a temperature lower than the glass transition temperature, preferably to a temperature about 30°C lower than the glass transition temperature (column 2, lines 6-10), while still maintaining the applied pressure on the substrates (column 3, lines 5-9). The reference provides multiple examples including some where the glass transition temperature of the material is 50°C (column 2, lines 42-45) or 87°C (column 3, lines 19-20) and therefore these materials are cooled down to a temperature of 20°C and 55°C, respectively (column 3, lines 25-27; Table in column 3).

The skilled artisan would have readily appreciated that Oshida is not limited to a particular material (see Table in column 3) and therefore use of a material having a glass transition temperature of 70°C would have been very likely wherein such a material would have been cooled down to about 40°C; especially since Oshida provides examples using materials that have a cool down temperature very close to that being claimed. More importantly, the skilled artisan would have appreciated that Oshida's desire to cool down to about 30°C below the glass transition temperature is only **preferable** and by no means limiting and therefore the skilled artisan would have chosen to cool down to a particular temperature based on the material being cooled such that sufficient cooling is achieved so as to prevent delamination once the applied pressure is released from the substrates.

7. On page 6 of the arguments, Applicant argues that Oshida teaches heating to a temperature of 20-50°C higher than the glass transition temperature of the material, which is in direct contrast to present claim 34 and Soane (which teaches heating to a temperature 2-5°C above the glass transition temperature).

The examiner points out that Applicant is arguing the references in a vacuum. Basically, Applicant is trying to argue that because each applied reference is not a 102 against the present claims they cannot be combined to render the present invention obvious. If such were the case, there would be no need for a 103-type rejection in patent prosecution!

More importantly, the examiner would like to remind Applicant that Oshida was not relied upon for how many degrees over the glass transition temperature it heats the substrates but instead was **only used to show** it being known in the microfluidic device art to bond two polymeric substrates made from the same or different thermoplastic materials using an adhesive-free bonding process wherein the substrates are heated to some temperature above their glass transition temperatures and then **cooled for a period of time and down a temperature which reads on the period of time and temperature being claimed in part (d) of Applicant's invention** to prevent overcooling (see p. 5-6 of previous office action for details regarding Oshida).

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